

Docket No. 217788US0CONT
IN RE APPLICATION OF: Shin KOIKE, et al.
SERIAL NO: 10/032,493
FILED: January 2, 2002
FOR: OIL COMPOSITION



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COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Transmitted herewith is an AMENDMENT AND REQUEST FOR RECONSIDERATION in the above-identified application.

- ☒ No additional fee is required
☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 is claimed.
☐ Additional documents filed herewith:

The Fee has been calculated as shown below:

CLAIMS	CLAIMS REMAINING		HIGHEST NUMBER PREVIOUSLY PAID	NO. EXTRA CLAIMS	RATE	CALCULATIONS
TOTAL	41	MINUS	45	0	x \$18 =	\$0.00
INDEPENDENT	1	MINUS	3		x \$84 =	\$0.00
		<input type="checkbox"/> MULTIPLE DEPENDENT CLAIMS			+ \$280 =	\$0.00
		TOTAL OF ABOVE CALCULATIONS				\$0.00
		<input type="checkbox"/> Reduction by 50% for filing by Small Entity				\$0.00
		<input type="checkbox"/> Recordation of Assignment			+ \$40 =	\$0.00
		TOTAL				\$0.00

☐ A check in the amount of \$0.00 is attached.

☒ Please charge any additional Fees for the papers being filed herewith and for which no check is enclosed herewith, or credit any overpayment to deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.

☒ If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time may be charged to Deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon

Registration No. 24,618



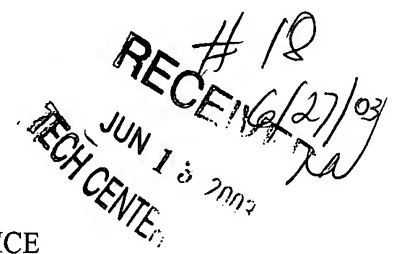
22850

Customer Number 22850
Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 05/03)

Richard L. Chinn, Ph.D.

Registration No. 34,305

DOCKET NO.: 217788US0CONT



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
SHIN KOIKE, ET AL. : EXAMINER: WEDDINGTON, K.
SERIAL NO: 10/032,493 :
FILED: JANUARY 2, 2002 : GROUP ART UNIT: 1614
FOR: OIL COMPOSITION :

RESPONSE AND REQUEST FOR RECONSIDERATION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Responsive to the outstanding Official Action of April 4, 2003, reconsideration of the above-identified application is respectfully requested in view of the following remarks:

REQUEST FOR RECONSIDERATION

Claims 6-35 and 40-50 remain active in this application with Claims 6-26, 34 and 35 being under active consideration.

The present invention is directed to an oil composition.

Applicants wish to thank examiner Weddington for the helpful and courteous discussion held with their U.S. representative on May 13, 2003. At that time, Applicants' U.S. representative argued the differences between the claimed invention and the claims of U.S. 10/061,286 and U.S. 6,448,292. The following is intended to expand upon the discussion with the examiner

Diglyceride compositions have been identified as having an obesity-preventing effect. In addition, ω 3 unsaturated fatty acids having at least 20 carbon atoms have been identified as

having effective physiological activities. However, ω 3 type unsaturated fatty acids having at least 20 carbon atoms can suffer from oxidation difficulties which can result in a loss of physiological activity. Accordingly, diglyceride containing compositions which are difficult to oxidize and yet have good flavor and physiological activities are sought.

The present invention addresses this problem by providing an oil composition comprising triglycerides, diglycerides and monoglycerides and a limited amount of free fatty acid wherein the acyl groups of the diglyceride defined in terms of an amount of ω 3 unsaturated acyl groups having at least 20 carbon atoms and an amount of monoenoic acyl groups. Applicants have discovered that such an oil composition provides for a useful diglyceride containing oil composition.

The rejection of Claims 6-26 under the judicially created doctrine of obviousness-type double patenting over Claims 1-9 and 11 over U.S. 6,448,292 is respectfully traversed.

U.S. 6,448,292 fails to disclose or suggest an oil composition as claimed.

Claims 1 and 6-8 of U.S. '292 are reproduced below. Claims 2-5, 9 and 11 do not describe the claimed diglyceride component and accordingly are not relevant to this analysis.

1. An oil composition comprising:

- i) 10-40% by weight of a diglyceride; and
- ii) 40.1 to 89.8% by weight of a triglyceride,

wherein said diglyceride is comprised of at least 55% by weight of constitutive acyl groups as unsaturated acyl groups, and wherein from 15 to 100% by weight of said acyl groups are ω 3 type unsaturated acyl groups having at least 20 carbon atoms; and wherein said triglyceride is comprised of at least 70% by weight of constitutive acyl groups as unsaturated acyl groups, and wherein from 5 to 80% by weight of said acyl groups are a **linoleyl** group.

6. The oil composition according to claims 1 or 2, wherein said ω 3 type unsaturated acyl group has 20 to 24 carbon atoms.
7. The oil composition according to claims 1 or 2, wherein 20-90% by weight of said acyl groups are ω 3 type unsaturated acyl groups having at least 20 carbon atoms.
8. The oil composition according to claims 1 or 2, wherein the number of carbon atoms in remaining acyl groups constituting said diglyceride is from 8 to 24.

Claim 1 simply recites that the diglyceride is comprised of at least 55% by weight of acyl groups, wherein 15-100% of said acyl groups are ω 3 type unsaturated acyl groups having at least 20 carbon atoms. There is **no disclosure** or suggestion of monoenoic acyl groups and an amount of 10-84.5% by weight.

In contrast, claim 6 recites a content of monenoic acyl groups of 10-84,5 % by weight. Applicants respectfully submit that there is no motivation provided by U.S. '292 to define the monoenoic acyl group compositions as 10-84.5% by weight and accordingly, the present claims are not obvious over the claims in U.S. '292.

In addition, the claims of U.S. '292 would not have been obvious over the present Claims 6-26.

More specifically, Claim 1 of U.S. '292 recites that the triglyceride is comprises of at least 70% by weight of constituted acyl groups as unsaturated acyl groups wherein 5-80% by weight of said acyl groups are **linoleyl** groups. Such a limitation is not found in Claims 6-26 of the present application and accordingly the present claims do not suggest a triglyceride limitation as to linoleyl groups. As the present claims would not have been obvious from Claims 1-9 and 10 of U.S. '292 and the claims of U.S. '292 would not have been obvious from the present claims, the rejection under the judicially created doctrine of obviousness-type double patenting is improper and should be withdrawn.

The rejection of Claims 6-26 and 34 and 35 as double patenting of all the claims of U.S. 10/061,286 is respectfully traversed.

None of the claims of U.S. 10/061,286 are directed to an oil composition or oral medicinal composition as claimed. The claims of U.S. 10/061,286 are directed to a method for preparing an oil composition (Claims 2, 3 and 7-17). Claims 1, 4 and 5 were canceled by preliminary amendment on March 11, 2002. Accordingly, the demarcation between the claims of the two applications is clear.

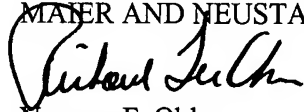
Moreover, the Examiner is reminded that a restriction requirement was issued in U.S. 10/061,286 in which claims directed to an oil composition were held to be patentably distinct from a method of preparing an oil composition. While claims directed to an oil composition were not active in U.S. 10/061,286 at the time that the restriction requirement was issued, none the less, it was the position of the U.S. Patent Examiner that an oil composition and a method of preparing an oil composition are patentably distinct and accordingly the present claims directed to an oil composition would not have been obvious based on the method claimed in U.S. 10/061,286. Accordingly, withdrawal of the rejection for double patenting is respectfully requested.

Applicants note that a typographical error appears in Example 4 on page 13 of the specification. The Example reports reaction of 40 parts by weight of glycerol. Applicants note, that the reaction was actually conducted with only 4 parts by weight of glycerol.

Applicants submit this application is now in condition for allowance and early notification of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAYER AND NEUSTADT, P.C.



Norman F. Oblon
Registration No. 24,618
Attorney of Record

Richard L. Chinn, Ph.D.
Registration No. 34,305



22850

Tel.: (703) 413-3000
Fax: (703) 413-2220
NFO:RLC:dbl